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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,861	12/05/2000	Robert Kaplan		9101

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Robert Kaplan
4 Creswick Walk
London, NW11 6AN
UNITED KINGDOM

EXAMINER

PEREZ DAPLE, AARON C

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,861

Applicant(s)

KAPLAN, ROBERT

Examiner

Aaron C Perez-Daple

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to Application filed 12/5/00 and Preliminary Amendment filed 11/23/04.
2. Claims 1-18 have been cancelled by Applicant.
3. New claims 19-31 are presented for examination.
4. This Action is non-Final.

Information Disclosure Statement

5. Under 35 CFR § 1.56, Applicant is required to submit an Information Disclosure Statement (IDS) including prior art known to be relevant to the instant application. This statement should include prior art cited in search reports of a foreign patent office in a counterpart application.

Specification

6. The disclosure is objected to because of the following informalities: appropriate section headings have not been included.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.

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- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

- 7. **Claim 19** is objected to because the term "Wherein" recited on line 13 should not be capitalized.
- 8. **Claims 28-31** are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 28-31 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

- 9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. **Claims 19-31** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As for claim 19, the term “computing devices” in lines 10-11 lacks proper antecedent basis because the prior recitation in line 5 refers only to a singular “computing device.” The term “receiving means” in line 11 lacks proper antecedent basis. For the purpose of applying prior art, the Examiner interprets that the “receiving means” refers to the “receiver” of line 7. The term “server locations” in line 11 lacks proper antecedent basis. It is not clear whether “server locations” is intended to refer to a physical location of the servers or merely the address of the servers.
11. As dependent claims, claims 20-31 suffer from the same deficiencies as claim 19.
12. As for claim 23, the end of the claim appears to have been cut off. For the purpose of applying prior art, the Examiner interprets that the last line should recite, “wherein said server is arranged to update said individual account data.”
13. As for claim 25, the term “said reading means” recited in line 5 lacks proper antecedent basis. For the purpose of applying prior art, the Examiner interprets that “said reading means” refers to the “receiver” of line 7 of claim 19.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. **Claims 19-21** are rejected under 35 U.S.C. 102(e) as being anticipated by Reber et al.

(US 5,938,726) (hereinafter Reber).

16. As for claim 19, Reber discloses a system for transferring or requesting data via a communication network via the Internet; comprising:

at least one or more communication network addressing apparatus, said apparatus each comprising:

a computing device having a modem (modem, col. 10, lines 28-32) and at least one or more communication linking programs stored therein (col. 5, lines 22-30); and

a receiver (data reader 30, Fig. 1; Fig. 14) for receiving data from a data carrier (col. 5, lines 5-15);

at least one or more Internet servers (node 24, Fig. 1) having stored therein at least one or more individual address locations (col. 3, lines 12-18); and

at least one or more data carriers (network navigation device 232, Fig. 14; Fig. 2) which are separate from said computing devices, said data receiving means and said server locations, said data carrier containing data in a form utilizable by said receiver (col. 5, lines 5-15);

wherein each of said communication addressing apparatus is characterized in that each said receiver contains within itself the means to interpret data as received from said carrier, then activate if not already active a communication link program in said computing device to

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enable the transferring of data indicative of an address location to said communication link program thereby forming a communication link via the Internet to a predetermined location (col. 5, lines 21-30; col. 6, lines 28-45).

17. As for claim 20, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claim 19 in that said receiving means includes the means to coordinate the transfer of any additional data from a data carrier to a server location after a communication link to said server location has been established (col. 5, lines 21-30).
18. As for claim 21, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claim 20 in that said system includes the means for an Internet server location being arranged to transmit or not transmit data following receipt of individual account data transmitted to said server location (col. 8, line 65 – col. 9, line 8).

Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. **Claims 22-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Reber in view of Herz et al. (US 5,754,938) (hereinafter Herz).

21. As for claims 22 and 23, Reber does not specifically disclose updating the individual account data. Herz teaches updating the individual account data (user profile data) stored in a server in order to match services and resources with a user's interests (col. 5, lines 19-65). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Reber by updating individual account data stored in a server in order to match services and resources with a user's interests, as taught by Herz above.
22. As for claim 24, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claims 19-22 in that the data carrier data predetermines the actions of said receiver when forming a communication link via the Internet utilizing said data carrier data (col. 5, lines 21-30).
23. As for claim 25, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claim 24 in that said receiving means further comprising the steps of determining whether server location address data also includes direct communication link data to a server location, wherein if said data also includes a direct communication link, said reading means being arranged to select then activate the correct communication path program in said computing device to enable the transfer of information to and from said server location via said communication link (col. 5, lines 21-30).
24. As for claim 26, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claim 25 in that said receiver contains the means to select then activate an email message program in said computing device to enable sending or receiving said message data (col. 11, lines 16-27).

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25. As for claim 27, Reber discloses a system for transferring or requesting data via a communication network via the Internet according to claim 19 in that said computing contains said receiving means that is inseparable or built within itself (data reader 174, Fig. 12; Fig. 14).



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Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,902,353, note Fig. 3;

US 5,905,251, note Fig. 1;

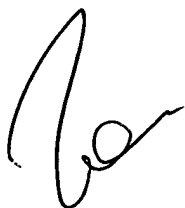
US 5,751,956, note Fig. 2 and abstract.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron C Perez-Daple whose telephone number is (571) 272-3974. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (571) 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aaron Perez-Daple



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100